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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/604,698	08/11/2003	Tang Foo Hou	SIC-03-014	1697
29863	7590	05/24/2006	EXAMINER	
DELAND LAW OFFICE P.O. BOX 69 KLAMATH RIVER, CA 96050-0069			BALDWIN, KATHLEEN C	
			ART UNIT	PAPER NUMBER
			3682	

DATE MAILED: 05/24/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary	Application No.	Applicant(s)	
	10/604,698	HOU, TANG FOO	
	Examiner	Art Unit	
	Kathleen Baldwin	3682	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 10 May 2006.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-6 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-6 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☒ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 11 August 2003 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--------------------------------------------------------------------------------------------------------------------------------------------------------------|-----------------------------------------------------------------------------------------|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date <u>5/10/06, 8/15/03, 8/11/03</u> | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

Election/Restrictions

1. Applicant's election of species I in the reply filed on 5/10/2006 is acknowledged. Because applicant did not distinctly and specifically point out the supposed errors in the restriction requirement, the election has been treated as an election without traverse (MPEP § 818.03(a)).

Claims 7-10 are withdrawn from further consideration pursuant to 37 CFR 1.142(b) as being drawn to a nonelected species, there being no allowable generic or linking claim. Election was made **without** traverse in the reply filed on 5/10/2006.

Specification

2. The disclosure is objected to because of the following informalities:

Page 8, line 21; page 12, line 4 and page 13, line 21: "operating member 14" is incorrect. The operating member is referenced as 18.

Page 14, line 28: "10" " is reference on drawing as "10' ".

The reference number 52 is used on the drawing but not disclosed in the specification. Appropriate correction is required.

Claim Rejections - 35 USC § 112

The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

3. Claim 2 is rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

Claim 2 recites, "operating member axis is spaced apart from the transmission..." which is not a further limitation of the independent claim (line 2). In claim 1, "...substantially parallel..." implies that the members are spaced apart. There is no further limitation in claim 2.

Claim Rejections - 35 USC § 102

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

4. Claims 1 and 2 are rejected under 35 U.S.C. 102(b) as being anticipated by Tagawa (US Patent 5,315,891).

Re clm 1, Tagawa ('891) discloses a bicycle shift control device comprising a base member (6) for attachment to the bicycle, an operating member (11) rotatably supported relative to the base member for rotating in first and second directions around an operating member axis (c 4, l 16-25); a transmission control member (13) rotatably mounted relative to the base member for controlling the pulling and releasing of a transmission control element (c 5, l

49-56) , wherein the transmission control member (13) rotates around a transmission control member axis that is substantially parallel to response to rotation of the operating member axis in operating member (11, c 4, 57-65), and an intermediate member (23) that moves in a direction of an intermediate member axis in response to rotation of the operating member (11) , wherein the intermediate member includes an intermediate member detent (35, c 5, l 11-20) for maintaining a rotational position of the operating member (11) and the transmission control member (13).

Re clm 2, Tagawa ('891) discloses the operating member (11) axis is spaced apart from the transmission control member (13) axis (see figure 4).

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this

Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

5. Claims 1-6 are rejected under 35 U.S.C. 102(e) as being anticipated by Hanatani (US Patent Application 2002/0128112).

Re clm 1, Hanatani discloses a bicycle shift control device comprising

a base member (14) for attachment to the bicycle, an operating member (20) rotatably supported relative to the base member (14) for rotating in first and second directions around an operating member axis (p 2, l 32-33); a transmission control member (46) rotatably mounted relative to the base member for controlling the pulling and releasing of a transmission control element (60) , wherein the transmission control member (46) rotates around a transmission control member axis that is substantially parallel to response to rotation of the operating member axis in operating member (see figure 2), and an intermediate member (44) that moves in a direction of an intermediate member axis in response to rotation of the operating member (20) , wherein the intermediate member includes an intermediate member detent (140 and 146) for maintaining a rotational position of the operating member (20) and the transmission control member (46).

Re clm 2, Hanatani discloses the operating member (20) axis is spaced apart from the transmission control member (46) axis (see figure 4).

Re clm 3, Hanatani discloses the operating member (20) axis is substantially coaxial with the intermediate member (44) axis (see figure 4).

Re clm 4, Hanatani discloses the intermediate member (44) is substantially nonrotatable relative to the base member (14).

Re clm 5, Hanatani discloses the operating member (20) includes a gear portion (130) that meshes with a gear portion of the transmission control member.

Re clm 6, Hanatani discloses the operating member (20) includes an operating member detent (132) that engages the intermediate member detent (142) for maintaining the rotational position of the operating member and the transmission control member (c 4, paragraph 56).

Conclusion

6. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure. Kageyama (US Patent 5,862,709) discloses a shift control device having a twist grip-operating member.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Kathleen Baldwin whose telephone number is 571-272-8973. The examiner can normally be reached on 7:30am-5pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Richard Ridley can be reached on 571-272-6917. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

KB 5/16/06

KB



RICHARD RIDLEY
SUPERVISORY PATENT EXAMINER